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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 705

J. C. PENNEY COMPANY, *Petitioner,*

v.

OLIVER F. MARSTON, *Respondent.*

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

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There are no grounds whatever stated in the Petition herein that establish any basis for bringing this case within the provisions of the rules of this Court.

This is an ordinary patent case, involving only the usual issues of validity and infringement. The District Court below held the Marston patent valid (PA p. 10), and the Court of Appeals for the Fourth Circuit unanimously affirmed this holding (Petitioner's Appendix B-24). The Court of Appeals further held that Petitioner's article infringed the patent (Id.)

As to Question II

Penney relies upon the decision of this Court in *Brenner* v. *Manson,* 383 U.S. 519 (1966), wherein this Court held that a patent must set forth utility.

In its decision, this Court stated that the reason for granting certiorari in that case was to resolve the dispute over

> "what constitutes 'utility' in chemical process claims".

The patent related to a process for making a certain chemical compound the utility of which compound was not stated. Hence this Court held the patent invalid for lack of utility.

By contrast, however, the present case relates to a mechanical structure, the utility of which can be determined at a glance.

There is no question but that the Marston patent involved in this case sets forth utility. Petitioner in its petition on page 7 *admits* "Here the patent disclosed an article which admittedly had practical, if commercially unproved utility".

The patent goes considerably further than merely suggesting an end use, or utility, for the unique, patented article. The first paragraph of the patent reads as follows:

> "This invention relates to flexible, waterproof, buoyant structures, and articles made therefrom, such as cushions, mattresses, life preservers, pillows, floats, bumpers, insulation units and the like."

The patent further states in column 2 beginning line 68:

> "It will also be apparent that the cushion 8 may be provided with any desired number of tabs or the like for securing it to a *chair* or other article." (Emphasis added)

Hence, the invention relates to a unique structure which, as clearly set forth in the patent, has a wide variety of end uses or utility.

Petitioner urges upon this Court an unwarranted extension of the *Manson* case to mechanical articles such that an inventor would not only be required to show utility for his invention, but would also have to see into the future and list all of the possible uses for the invention. Petitioner would then have the patent protection on the invention limited to the specific uses of the structure foreseeable by the inventor.

As applied to this case, Petitioner would not even be satisfied with a statement in the patent that the invention could be used in connection with *chairs,* (column 2, line 68 of the patent) but would further require that the inventor, Colonel Marston, foresee use of his invention in a particular type of chair such as the Penney chaise type of chair, a picture of which appears on page 5 of the Petition.

Incidentally, this picture of Petitioner's article appearing on page 5 is so poor as not to give the slightest idea of the details of construction. Respondent (Plaintiff) introduced as Exhibits in the lower court several other excellent photographs and another model, all of which show the striking similarity between Petitioner's and Respondent's structures, but, for the purposes

of this petition, Petitioner appears to have picked the least illuminating of the Exhibits.

If Petitioner's view were adopted by this Court, it would mean, for example, that three of the original models made by the inventor (such as shown on page 4 of the Petition), could be mounted on a frame to form a chaise type chair as shown on page 5. The original models prior to mounting on the frame would, of course, be considered infringements of the patent, but thereafter when the *same* units are mounted on the frame, they would immediately become noninfringing units.

To say the least, this would be a strange doctrine, having no precedents in the patent law.

As to Question I

It should not be necessary to recite the unique features in Colonel Marston's patented structure which formed the basis of its patentability.

The Court of Appeals for the Fourth Circuit said that (Appendix B of petition, p. 23)

> "The invention arises from the combination and arrangement of the various elements described in the claims, and the portion of the claims following the preamble is a self-contained description of the invention".

In the District Court, Petitioner (Defendant) failed to produce any expert testimony on the issue of validity. The District Court, after rejecting the references relied upon by Defendant, found the patent to be valid.

The Court of Appeals for the Fourth Circuit in its opinion fully considered the Patent Office history and

all of the prior art references asserted by Defendant. After a careful and complete analysis, the Court of Appeals also found the patent to be valid.

The Court of Appeals also found that the patent had been infringed, holding that Petitioner's construction (Appendix B 22)

> "is practically a 'Chinese copy' of the structure Marston describes in claims 1 and 2".

Both the District Court and the Court of Appeals held that Defendant did not avoid infringement because the invention is designated "A buoyant, flexible filler pad", as was done in the preamble or introduction to the claims. (Vol. II of Penney Appendix, PA 12 and 13, and Petitioner's Appendix B, p. 23).

Thereafter, the Fourth Circuit granted an extension of time for Petitioner to file its petition for rehearing, for the express purpose of considering this Court's decisions in the *Graham, Calmar, Adams* and *Manson* cases. In its petition for rehearing, Petitioner relied upon these decisions. The Fourth Circuit after considering this Court's decisions on the question of obviousness *denied* the petition for rehearing.

In discussing the Act of 1952, which included the controversial Section #103, this Court stated in its decision on the above cases (383 U.S. 1):

> "While the clear language of #103 places emphasis on an inquiry into obviousness, *the general level of innovation necessary to sustain patentability remains the same*". (Emphasis added)

Accordingly, since the Court of Appeals for the Fourth Circuit on petition for rehearing has considered all of the issues now being urged before this

Court, and has considered all of this Court's decisions now being relied upon by Petitioner, there is no reason for this Court to again review the matter.

It is therefore urged that the Petition for a Writ of Certiorari be denied.

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